

Remarks

The Applicants note with appreciation the withdrawal of the prior 35 U.S.C. §102 rejection based on Barzynski.

The Applicants also note with appreciation the Examiner's helpful suggestion with respect to Claim 6. Claim 6 has been amended to correct the minor typographical error.

The Applicants acknowledge the rejection of Claims 1 – 9 under 35 U.S.C. §103 over the hypothetical combination of the newly cited Boggs with Barzynski. Inasmuch as this is the first opportunity that the Applicants have had to address the issues raised by Boggs, the Applicants respectfully request the “finality” of the rejection be withdrawn. This is especially true in view of the fact that the majority of the subject matter added to independent Claims 1 and 6 in the previous Amendment came directly from originally filed dependent Claim 3.

In any event, we respectfully submit that one of ordinary skill in the art would have no incentive to make the combination in view of the lack of teachings or suggestions in either of Boggs or Barzynski to make such a hypothetical combination. Moreover, the Applicants respectfully submit that, even if the hypothetical combination were to be made, the resulting product would still fail to teach or suggest the invention as recited in the claims. In that regard, the Applicants note with appreciation the Examiner's thoughtful comments with respect to the disclosure of Boggs, especially in the paragraph spanning Columns 20 and 21 of Boggs. However, there are serious problems associated with that text, as well as other text in the Boggs disclosure. For example, that paragraph spanning Columns 20 and 21 states, among other things, that “an infrared absorbing substance is employed for converting infrared radiation into heat which is transferred to the heat-sensitive leuco dye... to form the dye chromophore.” Unfortunately, formation of a dye chromophore is exactly

what the claimed invention seeks to avoid. In other words, the application of heat causes the formation of a colored composition. The Applicants do not do this and do not want this. Instead, Claims 1 and 6 refer to a composition that evaporates or discolors (i.e., loses color).

This disclosure leads one of ordinary skill in the art away from the invention as recited in the solicited claims. There is nothing concerning a composition that evaporates at all. Instead, a new composition is formed. Alternatively, the text at Columns 20 and 21 teaches those of ordinary skill in the art that a composition is formed which is a dye or colored composition. Again, the Applicants seek to do the opposite and to provide a substantially colorless composition.

These teachings by Boggs are reinforced at an earlier location in their disclosure such as in the final paragraph of Column 6, beginning at line 61, which states:

The color developer moiety of the present invention may be any of the aromatic amino color developer moieties known or used in the photographic art to form a colored reaction product with a dye-forming coupler.

Nothing could be clearer than this portion of Boggs which specifically calls for a “colored” reaction product. There is utterly no indication in that disclosure that the composition evaporates as recited in the solicited claims and/or that it discolors or turns colorless. Instead, it is the deliberate formation of colored compositions that is a primary objective of Boggs.

The thermochromic system of Barzynski et al. is disclosed at Column 3, lines 6 to 14. That thermochromic system is a system in which an organic substance undergoes an optical density change under the influence of an activator. When the system is heated, the activator causes the color producing substance to form color from a colorless form. However, this invention is characterized in that the composition undergoes evaporation or discoloration, but not coloration. Accordingly, hypothetically utilizing the components of Boggs in the Barzynski disclosure would still result in a

product that is nowhere close to the invention as recited, which specifically calls for a composition that evaporates or discolors.

The consequence of this is that, assuming that one of ordinary skill in the art would have the motivation to make the hypothetical combination of the subject matter of Boggs with Barzynski, the hypothetical combination would still result in a completely different material that would require further modification to come close to the invention as recited herein. As a consequence, the hypothetical combination cannot support a rejection of the solicited claims. Withdrawal of the 35 U.S.C. §103 rejection is respectfully requested.

The Applicants also note with appreciation the Examiner's helpful comments concerning the previous amendment to Claim 1, which introduces a process of use limitation that only requires the composition to be "capable of" undergoing evaporation or discoloration. The Applicants respectfully submit that the previous amendment specifically stated that the composition "undergoes" evaporation or discoloration. This is not indicative of "capable of". Instead, this is an affirmative statement that one or the other phenomenon occurs to the composition.

In an effort to further clarify this fact, the Applicants have amended independent Claims 1 and 6 to recite that the composition "evaporates or discolors." Again, this is a more affirmative statement that the composition is not "capable of" undergoing evaporation or discoloration, but actually "evaporates or discolors." Accordingly, this is an affirmative recitation in both of Claims 1 and 6 that should be considered in evaluating those claims. This is especially true in the method steps wherein the "evaporates or discolors" language is particularly important by virtue of the fact that the very essence of method claims is action-type language which "evaporates" and "discolors"

are classic examples thereof. Withdrawal of the 35 U.S.C. §103 rejection of the solicited claims is respectfully requested.

In light of the foregoing, we respectfully submit that the entire Application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,



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